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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/935,116 09/22/97 DEATON

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EXAMINER

WM01/0607

RICHARD A. NEIFELD, ESQ.
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUST
1755 JEFFERSON DAVIS HIGHWAY
CRYSTAL SQUARE FIVE - FOURTH FLOOR
ARLINGTON VA 22202

GRAVINI, S

ART UNIT	PAPER NUMBER
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2162

DATE MAILED:

06/07/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/935,116

Applicant(s)
David W. DEATON et al.

Examiner
Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 20) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

1. Examiner objects to the tremendous volume of references. In order to aid the applicants with the duty of disclosure, MPEP 2004 suggests that it is desirable to avoid the submission of long lists of documents if it can be avoided. It also suggests to eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. Note *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d. 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied* 414 U.S. 874 (1974). Examiner considers the applicants' 13 pages of information disclosure statements to be a long list of documents and requests applicants to highlight those documents known to be of most significance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. Independent claims 8, 9, 10 and 11 recite "the stores" which lack a positive antecedent basis and dependent claims 12-14 are indefinite since each depends upon an indefinite claim (i.e. a claim lacking a positive antecedent basis). Examiner bases further art rejections on the assumption that the claims are not indefinite.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The body of the independently claimed invention recites dollar amounts and time periods which does not produce a useful, concrete or tangible result under *In re Alappat*, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Examiner does not give the preamble patentable weight under the *Kropa* and *Stencel* decisions (see infra paragraph 8). The recited dollar amounts and time periods are merely transaction data which do not result in a useful, concrete, or tangible result such that the inventor may be entitled to a patent. Examiner bases further art rejections on the assumption that the claims are statutorily permitted.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8, 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Creekmore (4,109,238). Creekmore discloses an system comprising: a terminal **13** for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction; means **26 & 27** for allowing entry of customer transaction data (the disclosed slot **26** and side **27** of the input terminal allows entry of customer transaction data because a customer enters an identification card transaction data **25**); a processor **19** and a memory **20** responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and circuitry **18 & 25** responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful ^{for} ~~pro-~~

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effectuating targeted customer promotion. Creekmore inherently generates customer information response signal as a function of analysis by circuitry of the individual customer's transaction following the detection of said unique identification code of the individual customer since the teachings of Creekmore disclose customer recognition and analysis.

8. Claims 33-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Bigari (5,010,485). Bigari discloses transaction data comprising dollar amount of purchases and time period along or alternatively total dollar amount of purchases purchased during a period of time associated with an identification of a customer (please see column 8 beginning at line 39 which cash register amounts calculated automatically until such time the purchase amount is less than or equal to the maximum charge amount). Bigari teaches an equivalent to the claimed invention since cash registers are associated with dollar amounts and the amounts are associated with purchases which are further limited by a period of time. Bigari inherently performs the claimed transaction data claim of dollar amount and time since the claimed invention performs the same function in the same way with the same results as taught in that reference. The number and frequency of transactions over periods of days and weeks is inherently taught in Bigari since merchants ^{use} ~~see~~ actual purchase amounts for daily and/or weekly accounting purposes (please see the last paragraph in column 8). The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). In claims directed to articles and apparatus, any phraseology in the preamble that

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limits the structure of that article or apparatus must be given weight. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). On the other hand, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Examiner does not give the preamble of the independently claimed transaction data patentable weight since it does not breathe life and meaning into the body of the claim. Furthermore examiner considers the preamble as merely reciting a purpose of the transaction data system and the body of the claim does not depend upon the preamble for completeness.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. (4,910,672). Creekmore discloses a method comprising entering into a point-of-sale terminal a unique identification code for a customer (please see column 3 lines 6-10 which teaches the equivalent entry of account information and personal code into a transaction processor as the claimed point-of-sale terminal customer unique identification code); entering into said terminal transaction data relating to the customer's shopping transaction (please see column 3 lines 19-45 which teaches the equivalent transaction processor **19** that performs the claimed terminal transaction data entry); generating and maintaining a database, including the step of correlating said transaction data with said unique identification code (please see column 3 lines 39-66 which teach the equivalent generating and maintaining steps throughout the check cashing master file **20**). Creekmore discloses the claimed invention except for the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer. Off et al.

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discloses that it is known to provide the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer, as set forth at column 9, lines 15-60 (the input data at a scanner including a keyboard generates a coupon which inherently performs the claimed step of responding to entry in the same manner with the same function with the same results). It would have been an obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore, by providing the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer, as taught by Off et al. in order to allow a more effective marketing scheme to reward frequent shoppers with targeted promotions.

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12. Claims 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. in further view of Tai (4,908,761). Creekmore in view of Off et al. discloses the claimed invention, as discussed above, except for the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit. Tai discloses that it is known to provide the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit, as set forth at column 3, lines 18-50. It would have been an obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore in view of Off et al., by providing the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit, as taught by Tai in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.

13. Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. in view of Tai in further view of Bigari. Creekmore in view of Off et al. in view of Tai discloses the claimed invention except for the dollar amount and time of purchase. Bigari discloses that it is known to provide a step of manipulating the dollar amount and time of purchase, as set forth at column 8, beginning with line 39. It would have been an obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore in view of Off et al. in view of Tai, by providing a step of manipulating the dollar amount and time of purchase, as taught by Bigari in order to more effectively target consumers while shopping for promotional offers designed by marketing agencies.

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Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 8, 9, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 5,305,196.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to add a terminal for a check transaction processing, database building and marketing method and system utilizing automatic check reading.

16. Claims 10, 11, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 26 of U.S. Patent No. 5,201,010 in view of Tai. It would have been obvious to one skilled in the art to add the feature of a response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.

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17. Claims 15 and 16 are rejected under the judicially created doctrine of double patenting over claim 12 of U. S. Patent No. 5,659,469 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the entering steps, the generating and maintaining steps, and the responding steps.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

18. Claims 17-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 5,529,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to claim broader subject matter than what is claimed in applicants' issued patent for an extension of patent rights.

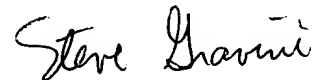
19. Claims 33-39 are rejected under the judicially created doctrine of double patenting over claims 1, 2, and 3 of U. S. Patent No. 5,592,560 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claimed dollar amount and purchase time.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

20. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". **If applicant(s) chose to send information be e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02.



STEPHEN GRAVINI

PRIMARY EXAMINER

smg

June 6, 2001